

### Remarks

Entry of the amendments presented, reconsideration of the application, and allowance of all pending claims are respectfully requested. Claims 13, 14, 16-19, 21-25, 27-29, 31, 32 & 34-36 remain pending.

By this amendment, each independent claim is revised to remove any perceived conditional language from the material recited. This amendment is submitted in response to the comments contained in the Advisory Action mailed September 25, 2003, and is submitted in a bona fide attempt to advance prosecution of the application.

The final Office Action rejected claims 13, 14, 16-19, 21-25, 27-29, 31, 32 & 34-36 under 35 U.S.C. §103(a) as being unpatentable over Trugman (U.S. Patent No. 5,887,141) in view of Benayoun et al. (U.S. Patent No. 5,771,227; hereinafter, "Benayoun"). Applicants respectfully, but most strenuously, traverse this rejection to any extent deemed applicable to the claims presented herewith and request reconsideration for the reasons set forth below.

An "obviousness" determination requires an evaluation of whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art. In evaluating claimed subject matter as a whole, the Federal Circuit has expressly mandated that functional claim language be considered in evaluating a claim relative to the prior art. Applicants respectfully submit that the application of these standards to the independent claims presented herewith leads to the conclusion that the recited subject matter would not have been obvious to one of ordinary skill in the art based on the applied patents.

Applicants recite a technique for dynamically changing message flow (e.g., claim 13). This technique includes dynamically changing a network of processes, while one or more messages of a plurality of messages are being processed in the network. The technique further includes determining completion of a problem associated with one or more messages of the plurality of messages, wherein the one or more messages have dynamically changed in number in response to the dynamic change in the network. The determining comprises checking a data structure to determine whether the problem is completed.

In another aspect of applicants' invention (e.g., claim 29), a technique for facilitating processing of transactions is recited to include dynamically changing a network of processes used in processing a plurality of messages of a transaction, the transaction having associated therewith a dynamic number of messages. The technique further includes determining completion of the transaction, wherein the network used in processing the plurality of messages of the transaction is dynamically changed, and the number of messages of the transaction dynamically changes during processing the plurality of messages due to the dynamic change in the network.

Applicants' above-summarized invention thus includes, in part, determining completion of a problem associated with one or more messages when the one or more messages have dynamically changed in number in response to the dynamic change in the network. Applicants respectfully submit that at least this feature of the claimed invention is not taught, suggested or implied by Trugman or Benayoun, alone or in combination.

Trugman discloses a system for efficiently distributing work from a server to remote/mobile nodes by providing a hierarchy of Session Work Objects (SWOs). Events in Trugman can be assigned to sessions, nodes and users via a hierarchy of SWOs (see col. 2, lines 51-58 and FIG. 1 thereof). The SWO work distribution system of Trugman is very different from applicants' invention.

In Trugman, a node (or session or user) sends an outgoing message (i.e., command) to cause an event associated with an SWO to occur, and an incoming message returns to that node with a result, which indicates that the event has been completed (see FIG. 2 and col. 6, lines 12-32 thereof). Thus, a node in Trugman expects one returned message to indicate the completion of the event. If this one returned message were to dynamically change in number during processing so that, for example, three messages were returned, Trugman's node would have to be non-obviously altered to be able to know that three, rather than one returned message, indicates the completion of the event (or problem). This type of node alteration is advantageously avoided in the present invention, which recites the determination of the completion of a problem, wherein the one or more messages associated with the problem have dynamically changed in number.

Relative to determining completion of a problem associated with one or more messages of the plurality of messages, the Office Action cites col. 6, lines 41-44, col. 7, lines 41-44, col. 7, lines 13-18, and col. 8, lines 21-35 of Trugman. The reference in column 6 states that SWOs are created for tasks to be completed at nodes and/or servers. Although this cited section refers to the completion of tasks, applicants respectfully submit that a teaching about merely the execution or the completion of a task (or even, or SWO) is not relevant to applicants' argument. Instead, applicants wish to emphasize the conditions under which the determining of the completion of a problem takes place, and note that Trugman is silent as to describing or suggesting the manner in which the completion of its tasks can be determined. More particularly, the cited section is silent as to determining the completion of a problem even though the number of the one or more messages associated with the problem has dynamically changed, as is recited in the claims presented herewith. Further, the column 7 reference describes the timing of event execution (i.e., before, during or after a communication session with a node has been established). Applicants again note that this referenced section does not discuss or suggest determining the completion of an event even though associated messages have dynamically changed in number. Still further, the column 8 reference describes defining events to automate workflow and maintenance activities and tagging the events for execution at certain times. Again, this cited section includes no teaching or suggestion of one or messages dynamically changed, as recited in the claims presented herewith.

This is expressly recognized in the Office Action at page 3, where it is stated that Trugman does not disclose having a system wherein a network is dynamically changing (let alone a system which determines completion of a problem in such an environment and under such characterizations as recited by applicants in the independent claims presented).

Benayoun is directed to the routing of messages in a multi-node data communication network. Benayoun describes a technique for routing messages through a network that is reconfigurable (see column 2, lines 17-24). The Office Action cites column 1, lines 59-62 as allegedly teaching applicants' recited concept of determining completion of a problem associated with one or more messages although the network has changed and even though the one or more messages associated with the problem have dynamically changed in number in

response to the dynamic change in the network. Clearly, a careful reading of Benayoun fails to uncover any teaching or suggestion of such a concept.

Column 1, lines 59-62 of Benayoun state:

In this way, all the network nodes may operate transparently without having to be configured or to stop the activity of the network each time a terminal or a node is added to the communication system.

The final Office Action further notes that"... (it should be noted that by responding to the change in the network corresponding changes in the number of messages sent would correspondingly be adjusted)". Thus, applicants understand the Examiner's rationale for the rejection to comprise an inherency argument wherein the Office Action asserts that the applicants recited functionality at issue would be inherent in Benayoun since Benayoun describes network nodes which may operate transparently without having to be configured and to stop the activity of the network each time a terminal or node is added to the communication system. This conclusion is respectfully traversed and reconsideration thereof is requested.

The doctrine of inherency is well-settled in patent law, and is best described in an excerpt from Hansgirk v. Kemmer, 26 C.C.P.A. 937, 102 F.2d 212,40 U.S.P.Q. 665 (1939):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [citations omitted.] If, however, the disclosure [of the cited reference] is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient [to anticipate the claimed invention].

Id. at 940, 102 F.2d at 214,40 U.S.P.Q. at 667; Stoller v. Ford Motor Co., 18 U.S.P.Q. 2d 1545, 1547 (Fed. Cir. 1991); Tyler Refrigeration v. Kysor Industrial Corporation, 227 U.S.P.Q. 845, 847 (Fed. Cir. 1985); Ex parte Levy, 17 U.S.P.Q. 2d 1461, 1464 (B.P.A.I. 1990); In re Oelrich and Divigard, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

In Ex parte Levy, the court stated that "[I]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings

of the applied prior art.” Ex parte Levy, 17 U.S.P.Q. 2d at 1464 (lengthy citation omitted) (italics added). The Examiner has not pointed to any passage in Benayoun where the number of messages associated with a given problem being processed necessarily changes in response to a dynamic change in the network. Absent such a showing, it is well established that claims are to be read in their entirety, including any functional limitations presented therein.

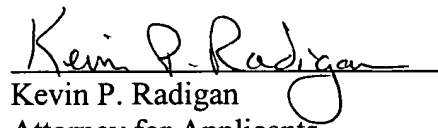
Since neither applied patent is believed to teach, suggest or imply determining completion of a problem associated with one or more messages, wherein the number of the one or more messages associated with the problem dynamically changes in response to a dynamic change in the network, applicants respectfully submit that one of ordinary skill in the art would not have considered a claimed invention obvious in view thereof. Applicants respectfully request reconsideration and withdrawal of this stated obviousness rejection as applied against the independent claims.

In addition, applicants traverse the combination of Benayoun and Trugman as being contrary to the express teachings of Trugman. Applicants respectfully submit that a dynamic adjustment of the network in Trugman would not be possible given the teachings thereof. Trugman describes throughout the patent (e.g. column 6, lines 19-33) an SWO work distribution system wherein events are statically defined. Specifically, the distribution system of Trugman must be brought offline in order to perform the procedure, for example, in FIG. 3 by creating an ESD or worklist SWO, and then restart it. The only way in Trugman to define a node is to redefine the SWOs and to change the SWOs, the entire work distribution system needs to be redeclared, which is taught to be done offline. A careful reading of Trugman and Benayoun fails to uncover any suggestion as to how Trugman could be modified to make such a system dynamically adjustable as asserted in the Office Action. For this additional reason, applicants request reconsideration and withdrawal of the obvious rejection to the independent claims based upon a purported combination of Trugman and Benayoun.

Further, the dependent claims are believed patentable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their own additional characterizations.

For all of the above reasons, applicants respectfully request reconsideration and withdrawal of the obviousness rejection of the dependent claims based upon the applied art.

Should the Examiner wish to discuss this case further with the Applicants attorney, the Examiner is invited to telephone the below-listed representative.

  
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